B.   REMARKS

This Amendment is submitted in response to the Examiner's Office Action dated February 9, 2007. Reconsideration of the application, as presently amended, is respectfully requested. Claims 1 through 48 were originally filed in this application. Claims 20, 24, 35, 37 and 40 through 48 were previously canceled. Claims 14 – 16, 18, 19 and 38 have been amended herein for clarity purposes and not for any reason related to the statutory requirements for patentability. Accordingly, Claims 1 through 19, 21 through 23, 25 through 34, 36, 38 and 39 are currently pending.

Favorable reconsideration of this application is respectfully requested for the reasons set forth in these remarks.

1.   *Claim Rejection – 35 U.S.C. § 112 – Claims 14 – 16 and 38*

Claims 14, 16 and 38 were rejected as failing to comply with the written description requirements. Claims 15 and 16 were rejected as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. Claims 14 through 16 and 38 are amended herein and are now in a condition for allowance.

2.   *Claim Rejection – 35 U.S.C. § 102(e) with Respect to Pickup et al. – Claims 1 – 10 and 25 - 34*

Claims 1 through 10 and 25 through 34 are rejected under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent Application Publication No. US2003/0050984A1 in the name of Pickup, et al. (hereinafter *"Pickup"*). Specifically, the Examiner asserts that, in independent claim 1, *Pickup* discloses each and every element of the invention claimed by the Applicants.

Under 35 U.S.C. § 102, each and every element of the claimed invention <u>must</u> be disclosed, either expressly or inherently, in a single prior art reference to invalidate a patent by anticipation. *Telefex, Inc. v. Ficosa North Am. Corp.*, 299 F.3d 1313, 1335 (Fed. Cir. 2002); *Bristol-Myers Squibb Co. v. Ben Venue Labs.*, 246 F.3d 1368, 1373 (Fed. Cir. 2001). The invention must be new or novel, and a challenger cannot prove anticipation "by combining more than one reference to show the elements of the claimed invention." DONALD S. CHISUM, CHISUM ON PATENTS § 3.02 (Rel. No. 71, Sept. 1999). Anticipation requires that "the four corners of a single, prior art document describe every element of the claimed invention, expressly or inherently, such that a person of ordinary skill in the art could practice the invention without undue experimentation." *Advanced Display Systems, Inc. v. Kent State University*, 212 F.3d 1272, 1282 (Fed.Cir.2000).

Applicants' Claim 1 read as follows (letters have been inserted prior to each element recited in the body of the claim for ease in identification in this Response):

> 1.   A method for providing backup electronic messaging services to wireless devices during outages, comprising:
> (A)   sending email messages from a primary email server to a user's wireless device;
> (B)   when said primary email system is unavailable, redirecting said email messages from said primary email system to a secondary email system and from said secondary email system to said user's wireless device;
> (C)   notifying said user that said email messages are available on said user's wireless device through said secondary email system at such time as said redirection of said email messages has been implemented;
> (D)   at such time as said primary email service becomes available, redirecting said email messages from said secondary email system to said primary email system and from said primary email system to said user's wireless device;
> (E)   notifying said user that said email messages are available on said user's wireless device through said primary email system at such time as said redirection of said email messages has been implemented; and

(F)   synchronizing said email messages received on said secondary email system while said primary email system was unavailable with the messages in said primary email system.

Applicants respectfully assert that the Examiner has failed to prove a prima facie case of anticipation in rejecting Independent Claim 1 and, by dependency, Claims 2 through 10. Because 35 U.S.C. § 102 requires that each and every element of the claimed invention must be disclosed in a single prior art reference to invalidate a patent by anticipation, *Pickup* must disclose each of Applicants' Elements A-F. Applicants respectfully assert that at least Elements C, E and F are not disclosed in *Pickup* and that, if any one of these elements is not disclosed, that alone is sufficient to invalidate *Pickup* as a prior art reference under § 102.

The Applicants respectfully direct the Examiner's attention to the following analysis of Elements C, E and F of Applicants' Claim 1, none of which are anticipated by *Pickup*.

(C)   notifying said user that said email messages are available on said user's wireless device through said secondary email system at such time as said redirection of said email messages has been implemented;

A careful reading of *Pickup* reveals that it teaches two distinct cases: one in which a registered user receives the original email but does not receive a notification and one in which a non-registered user receives a notification but does not receive the original email. In the first case, the registered user receives the original email, but does not receive a notification. *See Pickup*, Paragraph 0055 ("If the number refers to [a subscriber of the redirection service], mail server 1 generates an email transmission and forwards the text of the original email, entered by the subscriber, to the intended recipient over the Internet.")

In the second case, the <u>non-registered user</u> receives a notification, but <u>does not receive the original email</u>. *See Pickup*, Paragraph 0055 ("If the intended recipient's telephone number is not registered in the database, the system preferably contacts the recipient using the number entered by the user and notifies the recipient that a message is waiting for them at the redirection service's web site"); *see also*, Paragraph 0015 ("If the recipient's telephone number is <u>not</u> registered, the redirection service may forward to the recipient a notification that email is waiting for the recipient. The recipient may then access the redirection service's web site and register an email address in order to receive future email.") Therefore, *Pickup* teaches that the user <u>either</u> receives the original email messages <u>or</u> a notification, but *Pickup* does not teach that a user would ever receive both.

Applicants' Element C states that, as part of the claimed system, the user receives a notification that "email messages are available on the user's wireless device through said secondary email system at such time as said redirection of said email messages has been implemented." In other words, the user receives <u>both</u> a notification <u>and</u> the original email messages.

Because *Pickup* does not disclose a single process in which the user receives both a notification and email messages, it does not anticipate Applicants' Element C. Although the Examiner has attempted to combine two separate processes when formulating his rejection (i.e. the process in which a registered user's email messages are delivered to the user and the process in which a non-registered user receives a notification that email messages are waiting at a separate location), there is no teaching in *Pickup* of a single process in which a user receives both a notification and the original email messages. The courts have held that "anticipation is not established if it is necessary to pick, choose, and combine various portions of the disclosure not

directly related to each other by the teachings of the reference in order to show that the claims of the patent at issue are identically disclosed in the prior art." *Daiichi Pharmaceutical Co., Ltd. v. Apotex, Inc.*, 441 F.Supp.2d 672 (D.N.J. 2006). Accordingly, the Examiner cannot pick, choose and combine different processes described in *Pickup* to anticipate Applicants' Element C. To anticipate a patent, "an anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention." *Id.* There is simply no way in which one of ordinary skill in the art would have recognized that the two processes described in *Pickup* provided sufficient clarity and detail to establish that the single process in Applicants' Element C existed. *See* APPLICANT'S DECLARATION UNDER 37 C.F.R. § 1.132 ("APPLICANT'S DECLARATION"), Paragraph 7.a.

Because *Pickup* does not anticipate Applicants' Element C, it cannot anticipate each and every element of the claimed invention and it is therefore not a valid prior art reference. Accordingly, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claim 1 be withdrawn.

(E)   notifying said user that said email messages are available on said user's wireless device through said primary email system at such time as said redirection of said email messages has been implemented; and

Pickup teaches that a non-registered subscriber receives a notification that an email message is waiting at a remote location. *See Pickup*, Paragraph 0015 ("If the recipient's telephone number is not registered, the redirection service may forward to the recipient a notification that email is waiting for the recipient. The recipient may than access the redirection

service's web site and register an email address in order to receive future email. If the recipient does not already have an email address, the redirection service may offer the user an email account provided by the redirection service provider or alternatively refer the recipient to an email service provider."). *Pickup* also teaches that a user may obtain email messages from either a primary or a secondary email system but *Pickup* does not teach that a notification would be sent to the user in such cases. *See Pickup,* Paragraph 0013 ("All that the sender needs in order to send an email message to the recipient is the recipient's telephone number and the details of the redirection service domain. The message is then sent using a standard email program to an address [specified by the user]."). *Pickup* does not teach a process in which users are notified that email messages are available on their primary email system.

Applicants' Element E provides that a user is notified that the user's email messages are available on the user's wireless device through the user's primary email system. The notification in this element of the claim is not a notification that email is available through a backup service, a redirection service, or through some third party. Because *Pickup* only teaches a process whereby a user receives a notification that email messages are available through the redirection service's web site, there is no teaching in *Pickup* that a notification is sent to a user when emails are available through the user's primary email system after an outage as claimed in Applicants' Element E. *See* APPLICANT'S DECLARATION, Paragraph 7.b.

Because *Pickup* does not anticipate Applicants' Element E, it cannot anticipate each and every element of the claimed invention and it is therefore not a valid prior art reference. Accordingly, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claim 1 be withdrawn.

(F) *synchronizing said email messages* received on said secondary email system while said primary email system was unavailable with the messages in said primary email system.

Pickup does not teach the process of synchronizing email messages received on the secondary email system while the primary email system was unavailable with the messages in the primary email system. In fact, there is absolutely no mention in *Pickup* of synchronizing email messages between the primary email system and the backup email system.

In support of the Examiner's rejection of Element F, the Examiner generally identified Paragraphs 55-57 of *Pickup* and stated "the backup system 5 receives redirected email immediately after the mail server 1 fails, therefore the redirected mail is the same email as the email that is going to be directed to the mail server 1 at the time the mail server 1 is failed." Paragraphs 55-57 of *Pickup* describe a process in which mail is flowing to the backup system after the primary mail system fails. This simply shows the sequential nature of email flow upon failure of the primary system. When the primary mail server is unavailable, email traffic that was flowing through the primary mail server immediately begins flowing to the backup mail server. However, nowhere does *Pickup* teach that the email messages that flow through the backup server are synchronized with the email messages that flow through the primary server. In other words, *Pickup* discloses a system whereby email messages that flow through the backup server are retained on the backup server and email messages that flow through the primary server are retained on the primary server. A user looking at an email history log while mail is flowing through the backup server would see only those emails that flowed through the backup server and, once email messages again began flowing through the primary mail server, a user looking at the email history log on the primary server would see only the messages that flowed through the primary server. There is simply no discussion in *Pickup* of synchronizing the email messages on

the backup server with the email messages on the primary server.   *See* APPLICANT'S DECLARATION, Paragraph 7.c.

By stark contrast, Applicants' Element F describes a process for synchronizing the email messages received on the secondary email system while the primary email system was unavailable with the messages in the primary email system. This process is more than just simply redirecting email from one server to another, it is the process of synchronizing the messages flowing between the primary and secondary servers so that a user can view a single email history log. Without the synchronization process, a user would have to look at the email history log on the primary server and the secondary server in order to obtain a complete list of the email messages sent through the system.

Once again, because *Pickup* does not anticipate Applicants' Element F, it cannot anticipate each and every element of the claimed invention and it is therefore not a valid prior art reference.   Accordingly, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claim 1 be withdrawn.

Because *Pickup* does not anticipate each and every element of independent Claim 1, it cannot anticipate each and every element of Claims 2 through 10 which depend from Claim 1. Accordingly, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claims 2-10 be withdrawn.

Applicants' Claim 25 read as follows (letters have been inserted prior to each element recited in the body of the claim for ease in identification in this Response):

> 25.   A system for providing backup electronic messaging services to wireless devices during outages, comprising:

(A)   a primary email system, wherein said primary email system is configured for delivering email messages to said wireless devices;

(B)   a secondary email system, wherein said secondary email system is configured for delivering said email messages to said wireless devices at such time as said primary email system is unavailable;

(C)   at such time as said primary email system becomes unavailable, users of said wireless devices are notified that said primary email system is unavailable; and

(D)   at such time as said primary email service again becomes available, redirecting said email messages from said secondary email system back to said primary email system for delivery to said wireless devices, notifying said users that said email messages are available on said users wireless device through said primary email system, and synchronizing said email-messages received on said secondary email system-while said primary email-system was unavailable with the messages in said primary email system.

Applicants respectfully assert that the Examiner has failed to prove a prima facie case of anticipation in rejecting independent Claim 25 and dependent Claims 26 - 34. Because 35 U.S.C. § 102 requires that each and every element of the claimed invention must be disclosed in a single prior art reference to invalidate a patent by anticipation, *Pickup* must disclose each of Applicants' Elements A-D of Claim 25. Applicants respectfully assert that at least Element D is not disclosed in *Pickup* and that alone is sufficient to invalidate *Pickup* as a prior art reference under § 102.

The Applicants respectfully direct the Examiner's attention to the following analysis of Element D which is not anticipated by *Pickup*:

(D)   at such time as said primary email service again becomes available, redirecting said email messages from said secondary email system back to said primary email system for delivery to said wireless devices, <u>notifying said users that said email messages are available on said users wireless device through said primary email system,</u> and <u>synchronizing said email -</u>

messages received on said secondary email system-while said primary email-system was
unavailable with the messages in said primary email system.

There are at least two reasons that *Pickup* does not disclose each and every element of Element D. First, as stated above, *Pickup* teaches two separate cases: one in which a registered user receives the original email but does not receive a notification and one in which a non-registered user receives a notification but does not receive the original email. *See* APPLICANT'S DECLARATION, Paragraph 7. By contrast, Applicants' Element D states that, as part of the claimed system, the user receives a notification that "email messages are available on the user's wireless device through said secondary email system." In other words, the user receives both a notification and email messages.

Because *Pickup* does not disclose a single process in which the user receives both a notification and receives email messages, it can not anticipate Applicants' Element D. Although the Examiner has attempted to combine two separate processes when formulating his rejection (i.e. the process in which a registered user's email messages are delivered to the user and the process in which a non-registered user receives a notification that email messages are waiting at a separate location), there is no teaching in *Pickup* of a single process in which a user receives both a notification and the original email messages. The Examiner cannot pick, choose and combine different processes described in *Pickup* to anticipate Applicants' Element C. *Daiichi Pharmaceutical Co., Ltd. v. Apotex, Inc.*, 441 F.Supp.2d 672 (D.N.J. 2006). To anticipate a patent, "an anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention." *Id.* There is simply no feasible way in which one of ordinary skill in the art would have recognized that the two processes described in

Pickup provided sufficient clarity and detail to establish that the single process in Applicants' Element D existed. *See* APPLICANT'S DECLARATION, Paragraph 7.a.

Because *Pickup* does not anticipate Applicants' Element D, it cannot anticipate each and every element of the claimed invention and it is therefore not a valid prior art reference. Accordingly, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claim 25 be withdrawn.

The second reason that Pickup does not disclose each and every element of Element D is because *Pickup* does not teach the process of synchronizing email messages received on the secondary email system while the primary email system was unavailable with the messages in the primary email system. In fact, there is absolutely no mention in *Pickup* of synchronizing email messages between the primary email system and the backup email system. *See* APPLICANT'S DECLARATION, Paragraph 7.c.

In support of the Examiner's rejection of Element D, the Examiner generally identified Paragraphs 55-57 of *Pickup* and stated "the backup system 5 receives redirected email immediately after the mail server 1 fails, therefore the redirected mail is the same email as the email that is going to be directed to the mail server 1 at the time the mail server 1 is failed." Paragraphs 55-57 of *Pickup* describe a process in which mail is flowing to the backup system after the primary mail system fails. This simply shows the sequential nature of email flow upon failure of the primary system. There is simply no discussion in *Pickup* of synchronizing the email messages on the backup server with the email messages on the primary server. *See* APPLICANT'S DECLARATION, Paragraph 7.c.

Applicants' Element D describes a process for synchronizing the email messages received on the secondary email system while the primary email system was unavailable with the

messages in the primary email system. This process is more than just simply redirecting email from one server to another, it is the process of synchronizing the messages flowing between the primary and secondary servers so that a user can view a single email history log. Without the synchronization process, a user would have to look at the email history log on the primary server and the secondary server in order to obtain a complete list of the email messages sent through the system.

Once again, because *Pickup* does not anticipate Applicants' Element D, it cannot anticipate each and every element of the claimed invention and it is therefore not a valid prior art reference. Accordingly, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claim 25 be withdrawn.

Because *Pickup* does not anticipate each and every element of independent Claim 25, it cannot anticipate each and every element of Claims 26 through 34 which depend from Claim 25. Accordingly, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claims 26 through 34 be withdrawn.

3.   *Claim Rejection – 35 U.S.C. § 102(e) with Respect to Pickup et al. – Claim 11*

Applicant's Claim 11 reads as follows:

> 11.   A method for intercepting and redirecting email messages to wireless devices during an outage of the primary email system, comprising: during an outage of the company's primary email system, <u>intercepting email messages prior to such time as said email messages pass through the company's firewall</u> and redirecting said email messages to a pre-specified alternate location.

Applicants respectfully assert that the Examiner has failed to prove a prima facie case of anticipation in rejecting independent Claim 11 because *Pickup* does not disclose each and every

element of Applicants' Claim 11 for at least the reasons set forth below. Accordingly, Applicants respectfully assert that *Pickup* is not valid as a prior art reference under § 102.

Claim 11 of the Applicant's invention recites "intercepting email messages <u>prior to such time as said email messages pass through the company's firewall</u>." The process in *Pickup* does not include a step in which email is intercepted prior to passing through the company's fire wall. In fact, the opposite is true. *Pickup* provides that "internal administration network 8 is protected from the public Internet 3 and hackers from outside the development and administration network by firewall 17. *Pickup*, Paragraph 58. *Pickup* simply does not disclose interception outside the firewall. Accordingly, *Pickup* does not teach each and every element of Applicant's Claim 11, Element A.

For the reasons set forth above, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claim 11 be withdrawn.

4. *Claim Rejection – 35 U.S.C. § 102(e) with Respect to Pickup et al. – Claims 15 and 39*

Applicants' Claim 15, as amended, reads as follows (letters have been inserted prior to each element recited in the body of the claim for ease in identification in this Response):

> 15. A method for intercepting and redirecting email messages to wireless devices, comprising:
> (A) <u>intercepting, responsive to detection of an outage of a primary email system, email messages directed to non-functioning addresses within the primary email system</u> on a real-time basis, wherein said intercepting is performed during said outage of the primary email system;
> (B) redirecting said email messages to an alternate location; and
> (C) delivering said email messages from said alternate location to said wireless devices.

Applicants respectfully assert that the Examiner has failed to prove a prima facie case of anticipation in rejecting independent Claim 15 because *Pickup* does not disclose each and every element of Applicants' Element A for at least the reasons set forth below. Accordingly, Applicants respectfully assert that *Pickup* is not valid as a prior art reference under § 102.

The first reason that *Pickup* does not disclose each and every element of the Applicant's Claim 15 is because the process described in *Pickup* is a fundamentally different process than that claimed by the Applicants. In *Pickup*, the email messages are transmitted initially to a redirection service. *Pickup*, Paragraph 55. The redirection service then forwards the email messages on to the primary email server. *Id.* If the primary server is unavailable, the messages are redirected to a backup server. *Pickup*, Paragraph 57.

Claim 15, Element A of the Applicant's invention recites "intercepting, responsive to detection of an outage of a primary email system." The process in *Pickup* does not include a step in which in which email is "intercepted, responsive to a detection of an outage of a primary email system." In fact, all email in *Pickup* is sent through the redirection server. There is no interception that occurs, and certainly no interception that occurs in response to detection of an outage of the primary server. Accordingly, *Pickup* does not teach each and every element of Applicant's Claim 15.

The second reason that *Pickup* does not disclose each and every element of the Applicant's Claim 15 is because the Applicants are claiming a process of " intercepting . . . email messages directed to non-functioning addresses within the primary email system." Once again, in the process taught by Pickup, *all* email messages are sent to the redirection server. *Pickup* in no way contemplates intercepting only the email addresses that are directed to non-functioning email addresses. Moreover, in *Pickup*, email messages are redirected to the backup server "in

the event of catastrophic failure on the part of the [primary] mail server." *Pickup*, Paragraph 57.

In the event of such a catastrophic failure, "the backup server stores and processes any mail until

the primary mail server is brought back on line." *Id.* The fail-over in *Pickup* is an all-or-nothing

occurrence. Either the primary mail server has suffered a catastrophic failure or it is operational.

There is no discussion in *Pickup* of intercepting email messages on the primary mail server on an

address-by-address basis as is claimed by the Applicants. The requirements for intercepting and

redirecting email messages on an address-by-address basis are considerably different than the

requirements for intercepting email when the server has suffered a catastrophic failure. *Pickup*

simply does not disclose a method by which email messages may be intercepted on an address-

by-address basis. *See* APPLICANT'S DECLARATION, Paragraph 7.d. Accordingly, *Pickup* does not

teach each and every element of Applicant's Claim 15.

Because *Pickup* does not anticipate Applicants' Element A, it cannot anticipate each and

every element in Claim 15 of the claimed invention and it is therefore not a valid prior art

reference. Similarly, since Claim 32 is similarly directed towards redirecting email messages on

an address-by-address basis, *Pickup* does not anticipate that claim. Accordingly, Applicants

respectfully request that the Examiner's rejection under Section 102(e) with respect to Claim 15

and 39 be withdrawn.

5. ***Claim Rejection – 35 U.S.C. § 102(e) with Respect to Pickup et al. – Claim 16***

As amended, Applicant's Claim 16 reads as follows:

> 16. A method for intercepting and redirecting email messages to wireless devices, comprising:
> A. intercepting, responsive to detection of an outage of a primary email system, email messages intended for the primary email system within an email application designed to inspect email message traffic;
> B. redirecting said email messages to an alternate location; and

C. delivering said email messages from said alternate location to said wireless devices.

Applicants respectfully assert that the Examiner has failed to prove a prima facie case of anticipation in rejecting independent Claim 16 because *Pickup* does not disclose each and every element of Applicants' Element A for at least the reasons set forth below. Accordingly, Applicants respectfully assert that *Pickup* is not valid as a prior art reference under § 102.

Claim 16, Element A of the Applicant's invention recites "intercepting, responsive to detection of an outage of a primary email system." The process in *Pickup* does not include a step in which in which email is "intercepted, responsive to a detection of an outage of a primary email system." In fact, all email in *Pickup* is sent through the redirection server. There is no interception that occurs, and certainly no interception that occurs in response to detection of an outage of the primary server. Accordingly, *Pickup* does not teach each and every element of Applicant's Element A.

Also, *Pickup* does not disclose each and every element of the Applicant's element A is because the Applicants are claiming "email messages intended for the primary email system within an email application designed to inspect email message traffic." There is no discussion or teaching in *Pickup* of an application designed to inspect email message traffic. Accordingly, *Pickup* does not teach each and every element of Applicant's Claim 16, Element A.

Because *Pickup* does not anticipate Applicants' Element A, it cannot anticipate each and every element in Claim 16 of the claimed invention and it is therefore not a valid prior art reference.

For the reasons set forth above, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claim 16 be withdrawn.

6. *Claim Rejection – 35 U.S.C. § 102(e) with Respect to Pickup et al. – Claim 18*

Applicant's Claim 18 has been amended and Applicants respectfully assert that the present rejection is now moot. Accordingly, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claim 18 be withdrawn.

7. *Claim Rejection – 35 U.S.C. § 102(e) with Respect to Pickup et al. – Claim 19 and 21*

Applicants' Claim 19 has been amended and Applicants respectfully assert that the present rejection with respect to independent Claim 19, and Claim 21 which depends therefrom, is now moot. Accordingly, Applicants respectfully request that the Examiner's rejection under Section 102(e) with respect to Claims 19 and 21 be withdrawn.

8. *Claim Rejection – 35 U.S.C. § 103(a) with Respect to Pickup et al. in view of Weatherby et al. – Claims 12, 13 and 36*

Claims 12, 13 and 36 are rejected under 35 U.S.C. 103 as being unpatentable over *Pickup* in view of U.S. Patent Application Publication No. US2004/0054741A1 in the name of Weatherby, et al. (hereinafter "*Weatherby*"). Applicants respectfully submit that Claims 12, 13 and 36 are patentable over *Pickup* in view of *Weatherby* for the following reasons.

a.   *The Teachings of* Pickup *and* Weatherby *are Nonanalogous Art.*

The Federal Circuit has stated that "the consistent criterion for determination of obviousness is whether the prior art should have suggested to one of ordinary skill in the art that this process should be carried out and would have a reasonable likelihood of success." *Rockwell Int'l Corp. v. United States,* 147 F.3d 1358 (Fed. Cir. 1998). To make this determination, a court will "presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved." *In re Wood,* 599 F.2d 1032 (CCPA 1979). A reference is "reasonably pertinent" if

> "it is one which, because of the matter with which it deals, logically would have commended itself to the inventor's attention in considering the problem. . . . if the reference disclosure <u>has the same purpose</u> as the claimed invention [or] the reference <u>relates to the same problem.</u>" *In re Clay,* 966 F.2d 656 (Fed. Cir. 1992).

Pickup teaches a method of sending "email to a person when the person's email address is not known and of locating the Internet website of a business or person." *Pickup,* Paragraph 0005. The purpose of the invention described in *Pickup* is to redirect email to a user's mobile phone or a website. *Pickup,* Paragraphs 0006 - 0012. *Pickup* teaches a backup system but the purpose of the backup system is simply to "safeguard against failure" of the email redirection service taught by *Pickup. Pickup,* Paragraphs 0057. The method taught by *Pickup* is only concerned with redirecting email messages to a user's phone or a website. It does have the purpose, or relate to the problem, of email disaster recovery and, more specifically, is not concerned with notifying a user that email messages are available on a secondary system when the primary system is unavailable, notifying the user again when the primary system is available, and reconciling email messages received during the outage. *See* APPLICANT'S DECLARATION, Paragraph 7.a-c.

By stark contrast, the Applicants' invention teaches and claims a backup system for disaster recovery whereby, in the case of an outage of the user's primary email system, the user is notified that email is available on a secondary system. Moreover, once the functionality of the primary email system is restored, the user receives another message and, very importantly, the email messages received on the secondary system during the outage are synchronized with the email messages on the primary system so the user has access to a consolidated email history. *See* APPLICANT'S DECLARATION, Paragraph 7.a-c.

The Examiner acknowledges that "*Pickup* does not disclose [that] the interception happens after said email messages pass through a company's firewall." The Examiner then asserts that *Weatherby* discloses that the interception happens after the email messages pass through the company's firewall. However, *Weatherby* teaches a method and system which has a very different purpose and solves a different problem that the Applicants' invention. *See* APPLICANT'S DECLARATION, Paragraph 8. *Weatherby* teaches a system and method for limiting unsolicited commercial email. *Weatherby*, Paragraph 0003; Paragraph 0013. Nowhere in *Weatherby* is there a discussion of disaster recovery services, redirecting email to a secondary system, redirecting email back to a primary system, or synchronizing email messages thereafter.

Because *Pickup* (redirecting email to phone or website), *Weatherby* (limiting unsolicited commercial email) and the Applicants' invention (disaster recovery) all <u>have very different purposes</u> and <u>solve very different problems</u>, they cannot be considered "reasonably pertinent" to the problem in which the inventor was involved as required under *In re Clay* and, therefore <u>cannot be considered analogous art</u>. Accordingly, because non-analogous art cannot support a rejection under § 103, Applicants respectfully request that this rejection be withdrawn with respect to Claims 12, 13 and 36.

b.   *There is No Suggestion in* Pickup *or* Weatherby *to Combine References*

"Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention absent some teaching, suggestion, or incentive supporting the combination." *In re Geiger*, 815 F.2d 686 (Fed. Cir. 1987). A general relationship between the fields of the prior art references to be combined is insufficient to suggest the motivation." *Interactive Techs. Inc. v. Pittway Corp.*, Civ. App. No. 98-1464, slip op. at 13 (Fed. Cir. 1999). The combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only in hindsight, is insufficient to present a prima facie case of obviousness. There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992) (emphasis added).

As discussed above, the Internet redirection process taught by *Pickup* does not have the same purpose and does not solve the same problem and, therefore, because the reference is not "reasonably pertinent" to the Applicants' invention, it cannot be considered analogous art. Similarly, the process limiting unsolicited commercial email taught by *Weatherby* does not have the same purpose and does not solve the same problem and, therefore, because the reference is not "reasonably pertinent" to the Applicants' invention, it cannot be considered analogous art. It is unreasonable to conclude that one of ordinary skill in the art of disaster recovery would have consulted the field of email redirection and spam filtering when confronted with the problem of creating a synchronized solution to email recovery. There is no reason, suggestion, or motivation in either *Weatherby* or *Pickup* to notify a user that email messages are available on a secondary system when the primary system is unavailable, notify the user again when the

primary system is available, and reconcile email messages received during the outage, and there is certainly no suggestion to combine the cited references so that the interception happens after the email messages pass through the company's firewall. The courts are very clear that a "general relationship between the fields of prior art references is insufficient to suggest the motivation." *Interactive Techs.* at 13. While the Examiner may assert that the spam filtering in *Weatherby* is the same as the Applicants' disaster recovery field of art, this type of generalization is insufficient to form the basis of a rejection under Section 103. Accordingly, Applicants respectfully assert that the use of *Weatherby* and *Pickup* as prior art references under Section 103 is improper and requests that this rejection be withdrawn with respect to Claims 12, 13 and 36.

9. *Claim Rejection – 35 U.S.C. § 103(a) with Respect to Pickup et al. in view of Weatherby et al. – Claims 14 and 38*

Claims 14 and 38 are rejected under 35 U.S.C. 103 as being unpatentable over *Pickup* in view of *Weatherby*. Applicants respectfully submit that Claims 14 and 38 are patentable over *Pickup* in view of *Weatherby* for the following reasons.

a. The Teachings of Pickup *and* Weatherby *are Nonanalogous Art.*

With respect to Claims 14 and 38, the Examiner acknowledges that "*Pickup* does not disclose after said email messages enter said primary email system, but before said email messages leave an Internet mail collector." The Examiner then asserts that *Weatherby* discloses "after said email messages enter said primary email system, but before said email messages leave an Internet mail collector."

Once again, *Weatherby* teaches a method and system which has a very different purpose and solves a different problem that the Applicants' invention. *See* APPLICANT'S DECLARATION,

Paragraph 8. *Weatherby* teaches a system and method for limiting unsolicited commercial email. *Weatherby*, Paragraph 0003; Paragraph 0013. Nowhere in *Weatherby* is there a discussion of disaster recovery services, redirecting email to a secondary system, redirecting email back to a primary system, or synchronizing email messages thereafter.

Because *Pickup* (redirecting email to phone or website), *Weatherby* (limiting unsolicited commercial email) and the Applicants' invention (disaster recovery) all have very different purposes and solve very different problems, they cannot be considered "reasonably pertinent" to the problem in which the inventor was involved as required under *In re Clay* and, therefore cannot be considered analogous art. Accordingly, Applicants respectfully assert that the non-analogous art cannot support a rejection under § 103 and requests that this rejection be withdrawn with respect to Claims 14 and 38.

     b.   *There is No Suggestion in* Pickup *or* Weatherby *to Combine References*

As previously discussed, the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only in hindsight, is insufficient to present a prima facie case of obviousness. *Interactive Techs. Inc. v. Pittway Corp.*, Civ. App. No. 98-1464, slip op. at 13 (Fed. Cir. 1999). There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992) (emphasis added).

As discussed above, the Internet redirection process taught by *Pickup* does not have the same purpose and does not solve the same problem and, therefore, because the reference is not "reasonably pertinent" to the Applicants' invention, it cannot be considered analogous art. Similarly, the process limiting unsolicited commercial email taught by *Weatherby*

does not have the same purpose and does not solve the same problem and, therefore, because the reference is not "reasonably pertinent" to the Applicants' invention, it <u>cannot be considered analogous art</u>. It is unreasonable to conclude that one of ordinary skill in the art of disaster recovery would have consulted the field of email redirection and spam filtering when confronted with the problem of creating a synchronized solution to email recovery. There is no reason, suggestion, or motivation in either *Weatherby* or *Pickup* to alert a user that email messages are available on a secondary system when the primary system is unavailable, notify the user again when the primary system is available, and reconcile email messages received during the outage <u>and there is certainly no suggestion to combine the cited references so that the messages enter the primary email system but before the email messages leave an Internet mail collector</u>. The courts are very clear that a "<u>general relationship between the fields of prior art references is insufficient to suggest the motivation</u>." *Interactive Techs.* at 13. While the Examiner may assert that the spam filtering in *Weatherby* is the same as the Applicants' disaster recovery field of art, this type of generalization is insufficient to form the basis of a rejection under Section 103. Accordingly, Applicants respectfully assert that the use of *Weatherby* and *Pickup* as prior art references under Section 103 is improper and requests that this rejection be withdrawn with respect to Claims 14 and 38.

10.   Claim Rejection – 35 U.S.C. § 103(a) with Respect to Pickup et al. in view of Katsikas– Claim 17

Claim 17 is rejected under 35 U.S.C. 103 as being unpatentable over *Pickup* in view of U.S. Patent Application no. 2003/0191969 A1 issued to Katsikas (hereinafter "*Katsikas*").

Applicants respectfully submit that Claim 17 is patentable over *Pickup* in view of *Katsikas* for the following reasons.

  a.   *The Teachings of* Pickup *and* Katsikas *are Nonanalogous Art.*

With respect to Claim 17, the Examiner acknowledges that "*Pickup* does not disclose that a "mail server can be an SMTP host." The Examiner then asserts that *Katsikas* discloses that a "mail server can be an SMTP host."

Katsikas teaches a system for "eliminating unwanted email." *Katsikas*, Paragraph 002. This is a very different purpose and solves a different problem that the Applicants' invention. Nowhere in *Katsikas* is there a discussion of disaster recovery services, redirecting email to a secondary system, redirecting email back to a primary system, or synchronizing email messages thereafter.

Because *Pickup* (redirecting email to phone or website), *Katsikas* (eliminating unwanted email) and the Applicants' invention (disaster recovery) all have very different purposes and solve very different problems, they cannot be considered "reasonably pertinent" to the problem in which the inventor was involved as required under *In re Clay* and, therefore cannot be considered analogous art. Accordingly, Applicants respectfully assert that the non-analogous art cannot support a rejection under § 103 and requests that this rejection be withdrawn with respect to Claim 17.

  b.   *There is No Suggestion in* Pickup *or* Kastikas *to Combine References*

As previously discussed, the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only in hindsight, is insufficient to present a prima facie case of obviousness. *Interactive Techs. Inc. v. Pittway Corp.*, Civ. App. No. 98-

1464, slip op. at 13 (Fed. Cir. 1999). There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992) (emphasis added).

As discussed above, the Internet redirection process taught by *Pickup* does not have the same purpose and does not solve the same problem and, therefore, because the reference is not "reasonably pertinent" to the Applicants' invention, it cannot be considered analogous art. Similarly, the process of eliminating unwanted email taught by *Katsikas* does not have the same purpose and does not solve the same problem and, therefore, because the reference is not "reasonably pertinent" to the Applicants' invention, it cannot be considered analogous art. It is unreasonable to conclude that one of ordinary skill in the art of disaster recovery would have consulted the field of email redirection and spam filtering when confronted with the problem of creating a synchronized solution to email recovery. There is no reason, suggestion, or motivation in either *Kastikas* or *Pickup* to alert a user that email messages are available on a secondary system when the primary system is unavailable, notify the user again when the primary system is available, and reconcile email messages received during the outage and there is certainly no suggestion to combine the cited references so that a mail server can be considered a SMTP host. The courts are very clear that a "general relationship between the fields of prior art references is insufficient to suggest the motivation." *Interactive Techs.* at 13. While the Examiner may assert that the spam filtering in *Kastikas* is the same as the Applicants' disaster recovery field of art, this type of generalization is insufficient to form the basis of a rejection under Section 103. Accordingly, Applicants respectfully assert that the use of *Kastikas* and *Pickup* as prior art references under Section 103 is improper and requests that this rejection be withdrawn with respect to Claim 17.

11.   *Claim Rejection – 35 U.S.C. § 103(a) with Respect to Pickup et al. in view of Katsikas–*
Claims 22 and 23

Claims 22 and 23 are rejected under 35 U.S.C. 103 as being unpatentable over *Pickup* in view of *Katsikas*. Applicants respectfully submit that Claims 22 and 23 are patentable over *Pickup* in view of *Katsikas* for the following reasons.

> *a.*   *The Teachings of* Pickup *and* Katsikas *are Nonanalogous Art.*

With respect to Claims 22 and 23, the Examiner acknowledges that *"Pickup* does not disclose that a "mailbox is a pop3 mailbox or an imap4 mailbox." The Examiner then asserts that *Katsikas* discloses that a "mailbox is a pop3 mailbox or an imap4 mailbox."

As discussed in Section 10, *Katsikas* teaches a system for "eliminating unwanted email." *Katsikas*, Paragraph 002. This is a very different purpose and solves a different problem that the Applicants' invention. Nowhere in *Katsikas* is there a discussion of disaster recovery services, redirecting email to a secondary system, redirecting email back to a primary system, or synchronizing email messages thereafter.

Because *Pickup* (redirecting email to phone or website), *Katsikas* (eliminating unwanted email) and the Applicants' invention (disaster recovery) all <u>have very different purposes</u> and <u>solve very different problems,</u> they cannot be considered "reasonably pertinent" to the problem in which the inventor was involved as required under *In re Clay* and, therefore <u>cannot be</u> <u>considered analogous art</u>. Accordingly, Applicants respectfully assert that the non-analogous art cannot support a rejection under § 103 and requests that this rejection be withdrawn with respect to Claims 22 and 23.

b.   *There is No Suggestion in* Pickup *or* Kastikas *to Combine References*

As previously discussed, the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only in hindsight, is insufficient to present a prima facie case of obviousness. *Interactive Techs. Inc. v. Pittway Corp.*, Civ. App. No. 98-1464, slip op. at 13 (Fed. Cir. 1999). There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. *In re Oetiker*, 977 F.2d 1443 (Fed. Cir. 1992) (emphasis added).

As discussed above, the Internet redirection process taught by *Pickup* does not have the same purpose and does not solve the same problem and, therefore, because the reference is not "reasonably pertinent" to the Applicants' invention, it cannot be considered analogous art. Similarly, the process of eliminating unwanted email taught by *Katsikas* does not have the same purpose and does not solve the same problem and, therefore, because the reference is not "reasonably pertinent" to the Applicants' invention, it cannot be considered analogous art. It is unreasonable to conclude that one of ordinary skill in the art of disaster recovery would have consulted the field of email redirection and spam filtering when confronted with the problem of creating a synchronized solution to email recovery. There is no reason, suggestion, or motivation in either *Kastikas* or *Pickup* to alert a user that email messages are available on a secondary system when the primary system is unavailable, notify the user again when the primary system is available, and reconcile email messages received during the outage and there is certainly no suggestion to combine the cited references so that a mailbox is a pop3 mailbox or an imap4 mailbox. The courts are very clear that a "general relationship between the fields of prior art references is insufficient to suggest the motivation." *Interactive Techs.* at 13. While the

Examiner may assert that the spam filtering in *Kastikas* is the same as the Applicants' disaster recovery field of art, this type of generalization is insufficient to form the basis of a rejection under Section 103. Accordingly, Applicants respectfully assert that the use of *Kastikas* and *Pickup* as prior art references under Section 103 is improper and requests that this rejection be withdrawn with respect to Claims 22 and 23.

C.   CONCLUSION

In view of the foregoing remarks, the Applicants respectfully submit that all pending claims are allowable over the art of record and respectfully requests a timely Notice of Allowance. If the Examiner does not believe that the pending claims are in a condition for allowance, Applicants respectfully request a telephonic interview with the Examiner to clarify certain issues raised by the Examiner before the Examiner issues another Office Action.

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